REMARKS/ARGUMENTS

Claims 1-30 are pending in the present application.

This response is to respond the Office Action mailed December 9, 2008. In the Office Action, the Examiner rejected claims 1-30 under 35 U.S.C. §103(a). Applicant has amended claim 1 to correct minor informalities. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-3, 5-9, 11-13, 15-17, 21-23, and 25-29 under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0136462 A1 issued to Herber ("Herbert") in view of U.S. Patent No. 6,370,581 B2 issued to Rader ("Rader") and further in view of U.S. Publication No. 2002/0109706 A1 issued to Lincke ("Lincke"); and claims 4, 10, 14, 20, 24, and 30 under 35 U.S.C. §103(a) as being unpatentable over Herbert in view of Rader and further in view of Lincke and further in view of U.S. Publication No. 2003/0018558 A1 issued to Heffner ("Heffner"); and claims 8-9, 18-19, 28-29 under 35 U.S.C. §103(a) as being unpatentable over Herbert in view of Rader and further in view of Lincke and further in view of U.S. Publication No. 2001/0053978 A1 issued to Lewis ("Lewis"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a prima facie case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143, p. 2100-126 to 2100-130 (8th Ed., Rev. 5, August 2006).* Applicant respectfully submits that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Furthermore, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated: "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of

ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." MPEP 2141. In *KSR International Co. vs. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." The Court further required that an explicit analysis for this reason must be made. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR 127 S.Ct.* at 1741, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). In the instant case, Applicant respectfully submits that there are significant differences between the cited references and the claimed invention and there is no apparent reason to combine the known elements in the manner as claimed, and thus no *prima facie* case of obviousness has been established.

    1. Claims 1-3, 5-7, 11-13, 15-17, 21-23, and 25-27:

    Herbert discloses a system, device, computer program product, and method for repesenting a plurality of electronic ink data points. A pen-enabled computing device includes a writing stylus, a handwriting capture interface and a processing element. The handwriting capture interface may include an electronic handwriting tablet that is capable of sensing the position of the writing stylus. The processing element is capable of determining a high-order derivative of the electronic ink data points and thereafter encoding the high-order derivative of the plurality of electronic ink data points, such as by Huffman encoding. (Herbert, paragraph [0007], lines 7-18).

    Rader discloses a method, apparatus, and product for transmitting multibyte characters in a network. UTF-8 is an example of a variable-width or "multibyte" encoding format developed to support multilingual text (Rader, col. 2, lines 18-20). To create an HTTP request in UTF-8 format, web browser 220 will convert the data string from its current format to UTF-8 and transmit the UTF-8 data string and an HTTP request header across the network. An HTTP

request header typically contains information that server 130 requires to accurately parse the accompanying data string into bytes to understand the HTTP request (Rader, col. 6, lines 26-32).

Lincke discloses wireless, radio-frequency communications using a handheld computer. Because of the large latency, the number of packets sent over the wireless link should be kept small (Lincke, paragraph [0063], lines 4-7). The maximum packet size allowed over a low cost wireless network is 512 bytes (Lincke, paragraph [0105], lines 1-3). A message is transmitted using a compressed representation (Lincke, paragraph [0397], lines 6-9). The compressed representation are formatted according to a compact transport protocol having fields including input fields, control fields, and select fields (Lincke, paragraph [0397], lines 11-14). The maximum message size is especially important for low bandwidth communication system (Lincke, paragraph [0606], lines 7-9).

Herbert, Rader, and Lincke, taken alone or in any combination, do not disclose or render obvious, at least one of: (1) an encoder to encode data in a first format from an input device into a string of data having a second format supported by a server having an infrastructure, the first and second formats being different; (2) a packetizer coupled to the encoder to break the string of data into packets no larger than maximum message size allowed by the infrastructure, the packets having at least one packet having a header, the header identifying the first format; and (3) a management layer coupled to the packetizer to process the packetized string of data using a processing function, the processing function being enabled or disabled using a configuration user interface, as recited in claims 8, 18, and 28; or (4) a decoder to decode a received packet encoded in the second format back into the data having the first format, as recited in claims 1, 11, and 21.

Herbert merely discloses a handwriting capture interface to capture the (x,y) coordinates of the point of the stylus and a processing element to determine a high order derivative for each successive point and encode each high-order derivative (Herbert, paragraph [0029], lines 2-5; paragraph [0032], lines 3-7; paragraph [0036], lines 1-4), not an encoder to encode data in a first format from an input device into a string of data having a second format. Herbert discloses encoding the high-order derivatives for the successive points. From the raw (x,y) coordinates, the second derivatives for the successive points are determined (Herbert, paragraph [0033], Table 1). Then, the encoding is performed on the second derivatives. The encoding, therefore, is not

performed on the data from an input device, but on the second derivatives.   This second derivative format is not supported by a server having an infrastructure.

In addition, <u>Rader</u> merely discloses an HTTP request header typically contains information that server 130 requires to accurately parse the accompanying data string into bytes to understand the HTTP request (<u>Rader</u>, col. 6, lines 26-32), not a packetizer to break the string of data into packets no larger than maximum message size allowed by the infrastructure, the packets having at least one packet having a header, the header identifying the first format. <u>Rader</u> merely discloses the web browser converts the data string from its current format to UTF-8. Converting does not break the string into packets no larger than maximum message size allowed by the infrastructure. Furthermore, the HTTP request header merely allows the server to parse the data string, not to identify the first format.

Moreover, <u>Lincke</u> merely discloses keeping the maximum message size small for low bandwidth wireless communication system (<u>Lincke</u>, paragraph [0063], lines 4-7; paragraph [0105], lines 1-3; paragraph [0606], lines 7-9), not to break the string of data into packets no larger than maximum message size allowed by the infrastructure.   The objective of keeping the packet size small is to provide fast access to Web content (<u>Lincke</u>, paragraph [0061], lines 1-2). There is no infrastructure that allows a maximum message size.

2. <u>Claims 4, 10, 14, 20, 24, and 30:</u>

<u>Herbert</u>, <u>Rader</u>, and <u>Lincke</u> are discussed above.

<u>Heffner</u> discloses a system, method and computer program product for online financial products trading. A buyer can set up the account to monitor and "push" trading activity information to the user's computer screen-saver or window without having to be logged into the exchange system 200. This process of "pushing" uses the concept of instant messaging to listen for messages from the server and send notification of message to the subscriber's screen. (<u>Heffner</u>, paragraph [0257], lines 1-5).

As discussed above, <u>Herbert</u>, <u>Rader</u>, and <u>Lincke</u>, taken alone or in any combination, do not disclose or render obvious elements (1) – (3), or (1), (2), and (4) as above. Accordingly, a combination of <u>Herbert</u>, <u>Rader</u>, and <u>Lincke</u> with any other references in rejecting claims 4, 10, 14, 20, 24, and 30 is improper.

Furthermore, <u>Heffner</u> merely discloses the concept of instant messaging to listen for messages from the server and send notification of message to the subscriber's screen (<u>Heffner</u>, paragraph [0257], lines 1-5), not the infrastructure of a server that supports a second data format and allows a maximum size of packets. Alerting a buyer is not related to supporting a second data format and allowing a maximum size of packets.

3. Claims 8-9, 18-19, and 28-29:

<u>Herbert</u>, <u>Rader</u>, and <u>Lincke</u> are discussed above.

<u>Lewis</u> discloses a system and method for providing user-directed constraints for handwriting recognition. A user selects between a "default recognition" mode and a "constrained recognition" mode via a user interface. In the default recognition mode, a recognition engine utilizes predetermined default recognition parameters to decode data (e.g., handwriting and speech). In the constrained recognition mode, the user can select one or more of a plurality of recognition constraints which temporarily modify the default recognition parameters to decode uncharacteristic and/or special data. (<u>Lewis</u>, Abstract)

As discussed above, <u>Herbert</u>, <u>Rader</u>, and <u>Lincke</u>, taken alone or in any combination, do not disclose or render obvious elements (1) – (3), or (1), (2), and (4) as above. Accordingly, a combination of <u>Herbert</u>, <u>Rader</u>, and <u>Lincke</u> with any other references in rejecting claims 8-9, 18-19, and 28-29 is improper.

Furthermore, <u>Lewis</u> merely discloses a user to select between a default recognition and a constrained recognition, not a processing function being enabled or disabled using a configuration user interface. A user is not a processing function. Selecting between the two types of recognition is not the same as enabling or disabling the processing function. Selecting allows the user to choose one of the recognition types. It does not allow the user to enable or disable a processing function.

The Examiner failed to establish a prima facie case of obviousness and failed to show there is teaching, suggestion, or motivation to combine the references. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention;

and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Col, Inc.,* 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). "When determining the patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992), 24 USPQ2d 1040; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.,* 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. *Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432; *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992), 23 USPQ2d 1780.

Moreover, the Examiner failed to establish the factual inquires in the three-pronged test as required by the *Graham* factual inquires. There are significant differences between the cited references and the claimed invention as discussed above. Furthermore, the Examiner has not

made an explicit analysis on the apparent reason to combine the known elements in the fashion in the claimed invention. Accordingly, there is no apparent reason to combine the teachings of Herbert, Rader, Lincke, Heffner, and Lewis in any combination.

  The Examiner failed to establish a prima facie case of obviousness and failed to show there is teaching, suggestion, or motivation to combine the references. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Col, Inc.,* 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). "When determining the patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1312 (Fed. Cir. 1992), 24 USPQ2d 1040; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.,* 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. *Interconnect Planning Corp. v. Feil,* 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. *In re Rouffet,* 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp,* 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985). The mere fact

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In the present invention, the cited references do not expressly or implicitly disclose any of the above elements. In addition, the Examiner failed to present a convincing line of reasoning as to why a combination of Herbert, Rader, Lincke, Heffner, and Lewis is an obvious application of transmitting new data format under existing infrastructure or an explicit analysis on the apparent reason to combine Herbert, Rader, Lincke, Heffner, and Lewis in the manner as claimed.

Therefore, Applicants believe that independent claims 1, 8, 11, 18, 21, 28 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicants respectfully request the rejection under 35 U.S.C. §103(a) be withdrawn.

Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: January 12, 2009   By / THINH V. NGUYEN /
                                           Thinh V. Nguyen
                                           Reg. No. 42,034
                                           Tel.: (714) 557-3800 (Pacific Coast)

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025